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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,701	10/23/2000	Jang B. Rampal	1956-045	9837

22471 7590 12/19/2001

BECKMAN COULTER INC
4300 NORTH HARBOR BOULEVARD
P O BOX 3100
FULLERTON, CA 928343100

[REDACTED] EXAMINER

TUNG, JOYCE

ART UNIT	PAPER NUMBER
1656	6

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/694,701	Applicant(s) Rampal et al.
	Examiner Joyce Tung	Art Unit 1656
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
<p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Oct 3, 2001</u>.</p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<p>Disposition of Claims</p> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-54</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) <u>1-28 and 43-54</u> is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>29-42</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input checked="" type="checkbox"/> Claims <u>1-54</u> are subject to restriction and/or election requirement.</p>		
<p>Application Papers</p> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<p>Priority under 35 U.S.C. § 119</p> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some* c)<input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). 		
<p>*See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>		
<p>Attachment(s)</p> <p>15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) <input type="checkbox"/> Other: _____</p>		

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Response to Amendment

1. The amendment filed 10/03/2001 has been entered.
2. Regarding the restriction requirement, the response argues that Groups I-III should be examined together. As set forth in the Office action mailed 7/05/2001, Group II and Group III are distinct because the product, Group III can be used in protein purification or nucleic acid purification. The argument of the response that the example given is not a process that is materially different from that claimed is unclear what is meant (See pg. 2, the last paragraph). The response further argues that the fact that the target biopolymer binds to the probe biopolymer for the purpose of purification rather than for the purpose of detection. However, in the method steps there is no a step for the purpose of purification. Regarding the distinction of Inventions I and III, Group I and III are related as process of making and product made, Group I, claims 1-28 can be used to make affinity chromatography column, while the product, claims 43-54 can be used to make the magnetic beads for biopolymer detection. Thus, this is not found persuasive. The requirement is still deemed proper and is therefore made FINAL.
3. The rejection of claims 29-31 and 38-42 under 35 U.S.C. 112, first paragraph is withdrawn because of the argument.
4. The rejection of claims 29-31 and 38-42 under 35 U.S.C. 112, second paragraph is withdrawn because of the amendment

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5. Applicant's arguments with respect to the rejections of claims 29-34 and 38-42 under 35 U.S.C. 102(a) and (b) respectively anticipated by Matson et al. (5,981,185) and Rampal (6,013,789) have been considered but are moot in view of the new ground(s) of rejection.

THE FOLLOWINGS ARE NEW GROUND REJECTIONS

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 29-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Head et al. (6,322,968 B1).

Head et al. disclose a nucleic acid sequencing reagent comprising a sequence specific hybridizing region (See the Abstract). The disclosure is also describing a method of sequencing a template nucleic acid on a combinatorial array involving determining the identity of the extended sequence by detecting the incorporated labeled chain terminating nucleotide (See column 7, lines 19-43). The sequencing reagent can be non-specifically attached to a charged

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surface, such as an amino modified solid surface (See column 8, lines 63-65). The disclosure further indicates that under one preferred embodiment, the sequencing reagent can be specifically attached to solid surface by means of a non-covalent bond, for example, a biotin or iminobiotin labeled oligonucleotide may be immobilized to an avidin or strepavidin coated solid surface (See column 9, lines 3-7). The specification indicates that the biopolymer can be modified or unmodified in which the modified biopolymer may be biotinylated and the biopolymer may be adsorbed on a substrate by ionic and hydrophobic interaction (See pg. 8, lines 13-21). Thus, the teachings of Head et al. anticipate the limitations of claims 29-42.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (703) 308-1152.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal

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Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

December 6, 2001

A handwritten signature in black ink, appearing to read "Eggerton A. Campbell". The signature is fluid and cursive, with "Eggerton" having a large, prominent "E".

EGGERTON A. CAMPBELL
PRIMARY EXAMINER